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In re Application of	:	
DUBOIS	:	DECISION ON
Application No.: 09/194,996	:	
PCT No.: PCT/FR97/01024	:	RENEWED PETITION
Int. Filing Date: 10 June 1997	:	
Priority Date: 11 June 1996	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 146.1309	:	
For: TRANSDERMIC SYSTEMS ...	:	
MEDICAMENTS	:	

This decision is in response to applicant's facsimile transmission on 02 May 2002, which has been treated as a petition under 37 CFR 1.181. The petition requests that the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" and the declaration of Jean-Claude Vieillefosse submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 08 February 2002. No petition fee is due.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01024, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 04 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee and an unexecuted declaration.

On 20 April 1999, the USPTO mailed applicant a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 20 September 1999, applicant filed a "COMPLETION OF APPLICATION". The submission included, inter alia, a petition under 37 CFR 1.47(b); a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; a "Declaration Under Rule 47" by Jean-Claude Vieillefosse (hereinafter "first declaration of facts"); and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

On 14 February 2000, the USPTO mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had not been provided: factual proof that the inventor refuses to execute the application; a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 21 March 2000, applicant filed a renewed petition under 37 CFR 1.47(b). The renewed petition was accompanied by a "Supplemental Declaration Under Rule 47" (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse.

On 23 March 2000, applicant filed a "Supplement to the Renewed Petition" accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 26 July 2000, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had still not been provided: a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 03 August 2000, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 14 December 2000, the USPTO mailed a decision dismissing applicant's second renewed petition under 37 CFR 1.47(b). Specifically the decision noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 12 January 2001, applicant submitted a third renewed petition, which was accompanied by a declaration of Jean-Claude Vieillefosse.

On 17 May 2001, the USPTO mailed a decision dismissing applicant's third renewed petition under 37 CFR 1.47(b). Specifically, it was again noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 06 July 2001, applicant submitted a fourth renewed petition.

On 14 December 2001, the USPTO mailed a decision dismissing applicant's fourth renewed petition under 37 CFR 1.47(b). Specifically, it was again noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 02 May 2002, applicant submitted the instant facsimile transmission, which has been treated as a petition under 37 CFR 1.181. The petition requests that the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" and the declaration of Jean-Claude Vieillefosse submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 08 February 2002. The submission was accompanied by a copy of a date-stamped postcard receipt.

DISCUSSION

Petition Under 37 CFR 1.181

Applicants have provided sufficient evidence to establish that on 08 February 2002 applicants filed the documents listed above. The proof is in the form of the copy of the postcard receipt for the above-identified application which bears a USPTO date stamp of 08 February 2002 and which itemizes the documents listed above and identifies the above-captioned application number and docket number. In view of the postcard receipt, the documents received on 02 May 2002 may properly be accepted as originally received in the USPTO on 08 February 2002.

Renewed Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. It was noted in the decision mailed 14 February 2000 that applicant has satisfied items (1) and (6) above. The decision mailed 26 July 2000 noted that applicant has also satisfied item (2). The decision mailed 14 December 2000 indicated that items (3) and (4) had also been satisfied. All of the decisions indicated that item (5) had not been met.

Regarding item (5), the decision mailed 14 December 2000 indicated that it had not been established that the employee was performing an inventive task which corresponded to his actual

duties or was performing studies and research with which he had been explicitly entrusted. Applicant has provided another declaration of facts by Jean-Claude Vieillefosse. However, this declaration of facts is insufficient. First, it is noted that it contains apparently incorrect information. For example, this declaration of facts states that Jean-Claude Vieillefosse “was head of the [Patent Department of Aventis Pharma S.A.] during the time that Jean-Luc Dubois was employed by Aventis Pharma”. However, there is no evidence that Jean-Luc Dubois was ever employed by Aventis Pharma. Second, there is no evidence that Aventis Pharma is the 37 CFR 1.47(b) applicant. Third, even assuming arguendo that the declaration did not suffer from these first two problems, the declaration does not appear to be made by a person having firsthand knowledge of the facts that the employee was performing an inventive task which corresponds to his actual duties or was performing studies and research with which he had been explicitly entrusted. For example, the declaration states that Mr. Vieillefosse “received the invention disclosure for the present application submitted by Jean-Luc Dubois as a result of his research duties in accordance with his employment contract.” While Mr. Vieillefosse may have firsthand knowledge that he received this invention disclosure, it is not clear that he has firsthand knowledge that the employee was performing an inventive task which corresponds to his actual duties or was performing studies and research with which he had been explicitly entrusted. For example, it is not clear how Mr. Vieillefosse would have firsthand knowledge of Mr. Dubois’s “research duties.” Thus, it is not clear how Mr. Vieillefosse would have firsthand knowledge of whether what was described in the invention disclosure corresponded to Mr. Dubois’ actual duties or to studies and research with which Mr. Dubois had been explicitly entrusted.

Attention is directed to MPEP § 409.03(f) for information regarding proof of proprietary interest.

Also regarding item (5), the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor in the declaration submitted 20 September 1999 is Hoechst Marion Roussel. However, the employment contract of Mr. Dubois is with Roussel Uclaf. Also, the declaration for designation of inventors submitted as Exhibit A on 20 September 1999 is on Roussel Uclaf stationery. While it has been stated that Roussel Uclaf is the predecessor of Hoechst Marion Roussel (e.g., page 1 of “COMPLETION OF APPLICATION” filed 20 September 1999 and pages 1-2 of the declaration of facts by Jean-Claude Vieillefosse filed 20 September 1999), the precise relationship (e.g., company name change, merger, etc.) between the companies has not been provided. The precise relationship between Roussel Uclaf and Hoechst Marion Roussel must be explained and proof of the relationship must be provided. If the 37 CFR 1.47(b) applicant is now Aventis Pharma, the precise relationship between it, Hoechst Marion Roussel and Roussel Uclaf must be explained and proof of the relationship must be provided. Also, if the 37 CFR 1.47(b) applicant is now Aventis Pharma, a new declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor would likely be required.

CONCLUSION

For the above reasons, applicants’ renewed petition under 37 CFR 1.47(b) is **DISMISSED**,

without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". Extensions of time may be obtained under 37 CFR 1.136(a). No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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